

**RECEIVED
CENTRAL FAX CENTER****JUN 13 2008**Attorney Docket: 02280
U.S. Application No. 10/735,309 Art Unit 2611
Response to March 17, 2008 Office Action**REMARKS**

In response to the Office Action dated March 17, 2008, the Assignee respectfully requests reconsideration based on the above amendments and on the following remarks.

Claims 1-38 are pending in this application, with claims 32-38 being newly added.

Objection to Claim 5

The Office objected to claim 5 for mistaken dependency. Claim 5 has been amended to correctly depend from independent claim 1.

Rejection of Claims Under § 102 (e)

The Office rejects claims 1-10 and 12-29 under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent Application Publication 2003/0110489 to Gudorf, *et al.* A claim, however, is anticipated only if each and every element is found in a single prior art reference. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d (BNA) 1051, 1053 (Fed. Cir. 1987). *See also* DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2131 (orig. 8th Edition) (hereinafter "M.P.E.P.").

These claims are not anticipated by *Gudorf*. These claims recite, or incorporate, many features that are not disclosed or suggested by *Gudorf*. Independent claim 1, for example, recites "*performing a look-up to determine whether the first user command is locally stored in the viewer appliance, remotely stored at a network location, or stored in both the viewer appliance and in the network location.*" Support for such features may be found at least in the as-filed application at page 11, line 26 through page 12, line 10. Independent claim 1 is reproduced below, and independent claims 14, 23, 28, 29, 30, and 31 recite similar features.

Attorney Docket: 02280
U.S. Application No. 10/735,309 Art Unit 2611
Response to March 17, 2008 Office Action

1. A method of capturing user commands from a viewer that are related to viewing content, comprising:

receiving a first user command at a viewer appliance;

performing a look-up to determine whether the first user command is locally stored in the viewer appliance, remotely stored at a network location, or stored in both the viewer appliance and in the network location; and

executing the first user command at the viewer appliance.

Gudorf does not anticipate all these features. *Gudorf* discloses click stream data that is time stamped and analyzed to determine a profile. See U.S. Patent Application Publication 2003/0110489 to Gudorf, *et al.* at paragraphs [0009] and [0010]. The clickstream data may be analyzed locally or remotely. See *id.* at paragraph [0011]. Still, though, *Gudorf* fails to teach or suggest “performing a look-up to determine whether the first user command is locally stored in the viewer appliance, remotely stored at a network location, or stored in both the viewer appliance and in the network location.” Because *Gudorf* is silent to at least these features, *Gudorf* cannot anticipate independent claims 1, 14, 23, 28, and 29.

Claims 1-10 and 12-29, then, are not anticipated by *Gudorf*. Independent claims 1, 14, 23, 28, and 29 recite many features that are not taught or suggested by *Gudorf*. The dependent claims incorporate these same features and recite additional features. Claims 1-10 and 12-29, then, are not anticipated, so the Office is respectfully requested to remove the § 102 (e) rejection of these claims.

Rejection of Claims 30 & 31 under § 102 (e)

The Office rejects claims 30 and 31 under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 7,212,979 to Matz, *et al.*

Again, though, independent claims 30 and 31 are not anticipated by *Matz*. These claims again recite features that are not disclosed or suggested by *Matz*. Independent claim 30, for example, recites “performing a look-up to determine whether the first user command is locally

Attorney Docket: 02280
U.S. Application No. 10/735,309 Art Unit 2611
Response to March 17, 2008 Office Action

stored in the viewer appliance, remotely stored at a network location, or stored in both the viewer appliance and in the network location." Independent claim 31 recites similar features. Because *Matz* fails to teach or suggest these features, *Matz* cannot anticipate independent claims 30 and 31. The Office is respectfully requested to remove the § 102 (e) rejection of these claims.

Rejection of Claim 11 under § 103 (a)

The Office rejects claim 11 under 35 U.S.C. § 103 (a) as being obvious over *Gudorf* in view of U.S. Patent 6,718,551 to *Swix, et al.*

Swix, however, cannot be cited against the pending claims. Subject matter that was commonly owned at the time of invention, but developed by another person, shall not preclude patentability. See 35 U.S.C. § 103 (c). This application (U.S. Application 10/875,712) and U.S. Patent 6,718,551 to *Swix, et al.* were commonly owned at the time of invention by the same assignee (namely, BellSouth Intellectual Property Corporation, now doing business as AT&T Delaware Intellectual Property, Inc.). *Swix* is a U.S. Patent with an earlier filing date and a different inventive entity. *Swix*, then, would qualify under 35 U.S.C. § 102 (e), which is precluded by 35 U.S.C. § 103 (c).

The Assignee, then, respectfully asserts that *Swix* cannot be cited against the pending claims. The Office is thus respectfully requested to remove the § 103 (a) rejections based on any combination involving *Swix*.

New Claims 32-38

This response presents new claims 32-38. Independent claim 32 presents several features that are not taught or suggested by *Gudorf, Matz*, and/or *Swix*, and dependent claims 33-38 incorporate these features. The Assignee thus respectfully asserts that claims 32-38 distinguish over *Gudorf, Matz*, and/or *Swix*. Support for these features may be found at least at column 6, lines 55-58, column 9, lines 55-67, at column 7, lines 10-11, at Table II, and at Table IV of U.S.

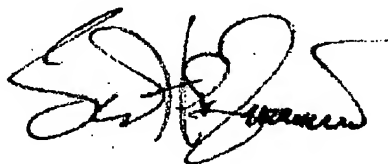
Attorney Docket: 02280
U.S. Application No. 10/735,309 Art Unit 2611
Response to March 17, 2008 Office Action

Application 09/496,825, now issued as U.S. Patent 6,983,478 (Attorney Docket 95003 CON). Support may also be found at page 9, line 30 through page 10, line 5 of the as-filed application. Support may also be found at least in the as-filed application at page 11, line 26 though page 12, line 10.

A \$550 excess claim fee is due. New independent claim 32 requires \$200, and claims 32-38 require \$350 ($7 \times \$50 = \350). The total excess claim fee is thus \$550, and credit card authorization is enclosed.

If any questions arise, the Office is requested to contact the undersigned at (919) 387-6907 or scott@scottzimmerman.com.

Respectfully submitted,



Scott P. Zimmerman
Attorney for the Assignee
Reg. No. 41,390